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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,051	06/02/2005	John Francis Dufort	001058-00025	4299

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BLANK ROME LLP
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON, DC 20037

EXAMINER

HYLINSKI, ALYSSA MARIE

ART UNIT	PAPER NUMBER
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3711

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/517,051

Applicant(s)

DUFORT, JOHN FRANCIS

Examiner

Alyssa M. Hylinski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-24, 26, 27, 29-31 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-24, 26, 27, 29-31 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/12/07 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4-11, 18-24, 26-27, 29-31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pfister (DE 10013829 A1) and Williams (3596380). Pfister discloses a spinning top having a body (12) and a stem (11). The stem is movable between a first position where the stem is entirely received within the body such that it is substantially parallel to the body (Fig. 1A) and a second position in which the stem extends perpendicularly through an opening formed in the body (Fig. 1B). The stem can be moved back and forth between the first and second positions (Figs. 1A & 1B). The stem has arms or pivot pins (119) protruding from its sides, engaging holes

(14) in the body thereby pivotally mounting the stem to the body (Figs. 1A & 1B). The opening is sized to allow the stem to move there through when moving between the first and second positions (Figs. 1A & 1C). The profile or outline of the stem varies along the length of the stem and has a larger cross-sectional area halfway along its length formed by a circular portion (Fig. 1D). The stem has a pointed tip (114) and a handle portion (112). The body is a substantially planar circular disk (Fig. 1B). Pfister discloses the basic inventive concept with the exception of the body having a substantially continuous outer perimeter and a recess. Williams discloses a spinning top (Fig. 7) having a unitary one-piece body (13) with a substantially continuous outer perimeter (Fig. 7) and a stem (12) that is moveable from a first position in which the stem lies substantially parallel to the body (Fig. 1) and a second position in which the stem extends perpendicularly through a center opening in the body (Fig. 7). The stem is received within a recess (24) formed by the concave sidewall of the body (Figs. 2 & 3) and is entirely received within the body when in the first position (Figs. 1 & 2). The stem can be moved back to the first position after use (Figs. 7 & 1) and is separable from the body (Fig. 5). The stem is pivotally mounted on the body (column 1 lines 5-12) and the opening is sized to allow the stem to move there through when moving between the first and second positions (Fig. 7). The stem is formed with a convex latch portion forming a tab (19) that engages a corresponding concave latch portion (24) on the body with a tab formed by the outer wall (Fig. 3) when the stem is in the second position (Fig. 7) to prevent rotation of the stem with respect to the body. The profile of the stem varies along its length with a section of larger cross-sectional area located about half way

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along its length giving the stem a circular profile with a rounded tip (Fig. 7). It would have been obvious to one of ordinary skill in the art to include an additional outer ring with a substantially continuous perimeter to the body of the top toy of Pfister since such a modification would have involved a mere change in the shape of a component. It has been held that a change in shape would be an obvious matter of design choice to a person of ordinary skill in the art. *See in re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). It would have been obvious to one of ordinary skill in the art to add the recess as disclosed in Williams to the top of Pfister in order create a locking mechanism that will hold the stem in the desired configurations when in use.

4. Claims 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pfister, Williams and Heidenreich (1139119). Pfister and Williams disclose the basic inventive concept, substantially as claimed, with the exception of an outer element. Heidenreich discloses a circular disk shaped piece of paper with a center hole that functions as an outer element attaching to and extending over a majority of a top part of a body and partially secured by a flange on the body of the toy (page 1 lines 47-53). It would have been obvious to one of ordinary skill in the art from the teaching of Heidenreich to include the outer element in order to incorporate advertising matter onto the toy. The outer element being removably mounted to the top and bottom of the body would have been an obvious matter of design choice to a person of ordinary skill in the art because Applicant has not disclosed that having the outer covering being removable from both the top and bottom of the body provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would

have expected Applicant's invention to perform equally well with the covering being permanently adhered to just the top of the body because it would allow an advertisement to be easily seen and prevent a person from removing the advertisement at a later time. In regard to the outer element being made of resilient material, examiner notes that the mere selection of known materials as recited in claim 17, on the basis of suitability for the intended use would be entirely obvious. See in re Leshin, 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious to one of ordinary skill in the art to provide Heidenreich with resilient material in order to use a known material suitable for the intended use.

Response to Arguments

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Hylinski whose telephone number is 571-272-2684. The examiner can normally be reached on M-F (8-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMH



EUGENE KIM
SUPERVISORY PATENT EXAMINER